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REMARKS

Claims 1, 2, 4, 8, 10-13, 15, 19, 21-24, 26, 30, 50 and 51 stand rejected under 35 U.S.C § 102(e) as being anticipated by Bartholomew *et al.* (U.S. Patent No. 6,167,119). Claims 3, 5, 6, 7, 9, 14, 16, 17, 18, 20, 25, 27, 28, 29, 42, and 47 stand rejected under 35 U.S.C § 103(a) as being unpatentable over Bartholomew in view of McAllister (U.S. Patent No. 6,101,242), Timonen (U.S. Pub. No. 2002/0058494), Silverman (U.S. Patent No. 6,167,119), Baker (U.S. Patent No. 5,533,109). Claims 40, 41, 43-46, 48, 49, and 52 stand rejected under 35 U.S.C § 103(a) as being unpatentable over Gallick (U.S. Patent No. 6,678,359) in view of well-known prior art. As will be shown below, Bartholomew, McAllister, Timonen, Silverman, Baker, and Gallick alone or in combination, do not teach a method, system, or computer program product for identifying a particular callee as claimed in the present application. Claims 1-30 and 40-52 are therefore patentable and should be allowed. Applicants respectfully traverse each rejection individually below and request reconsideration of claims 1-30 and 40-52.

Claim Rejections – 35 U.S.C. §102

Claims 1, 2, 4, 8, 10-13, 15, 19, 21-24, 26, 30, 50, and 51 stand rejected under 35 U.S.C § 102(e) as being anticipated by Bartholomew *et al.* (U.S. Patent No. 6,167,119). To anticipate the claims of the present invention under 35 U.S.C. § 102(e), two basic requirements must be met. The first requirement of anticipation is that Bartholomew must disclose each and every element as set forth in Applicants' claims. The second requirement of anticipation is that Bartholomew must enable Applicants' claims. Bartholomew does not meet either requirement and therefore does not anticipate Applicants' claims.

Bartholomew Does Not Disclose Each and Every Element of Applicants' Claims

Bartholomew does not disclose each and every element of Applicants' claims. "A claim is anticipated only if each and every element as set forth in the claim is found, either

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expressly or inherently described, in a single prior art reference.¹ The present application is entitled "Origin Device Based Callee Identification" and each independent claim in the case recites "an origin device." More specifically, the Office Action bases its rejection on the rationale that an IP as disclosed in Bartholomew is an "origin device" as claimed in claims 1, 2, 4, 8, 10-13, 15, 19, 21-24, 26, 30, 50 and 51. The IP of Bartholomew is an acronym for "intelligent peripheral." Independent claim 1, for example, recites "[a] method for identifying a particular callee, said method comprising . . . detecting, *at an origin device*, a voice utterance . . . and identifying, *at said origin device*, a callee identity associated with said utterance." Independent claims 12 and 23 recite system and computer program product claims corresponding to independent claim 1. Independent claim 40, for example, recites "[a] method for identifying a callee, comprising: . . . detecting, a voice utterance of a callee *at an origin device*, . . . authenticating an identity of said callee from said voice utterance *at said origin device*; and enabling output of said authenticated identity *from said origin device*, such that a caller accessing *said origin device* is informed of an identity of said callee." Independent claim 50 claims computer program product claim corresponding to independent claim 40. Rejected claims 2, 4, 8, 10, 11, 13, 15, 19, 21, 22, 24, 26, 30 and 51 depend from independent claims 1, 12, 23, 40, and 50 and include all of the limitations of those independent claims. Applicants maintain their position that the intermediary IP of Bartholomew is not an origin device.

In rejecting claims 1, 2, 4, 8, 10- 13, 15, 19, 21- 24, 26, 30, 50 and 51, the Office Action states without further explanation that the term origin device includes the intermediary IP of Bartholomew. The intermediary IP of Bartholomew is not an origin device as recited in claims 1, 2, 4, 8, 10- 13, 15, 19, 21- 24, 26, 30, 50 and 51, but is instead an "intelligent peripheral," which is an intermediary network component. Bartholomew specifically incorporates the definition of the IP from another patent to Wheeler, Jr.² who describes

¹ *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

² U.S. Patent No. 6,167,119, column 11, line 63 – column 12, line 6 ("IP 23 is essentially similar to that disclosed in commonly assigned U.S. U.S. [sic] Pat. No. 5,572583 to Wheeler, Jr. et al. . . . the disclosure of the network and operation of the IP disclosed from that Patent is incorporated herein in its entirety by reference.")

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the IP as "a separate network component that . . . is distinct from the telephone company switching offices, trunk networks and any associated interoffice signaling network."³ In fact, Bartholomew specifically teaches away from the Office Actions' characterization of an intermediary IP as an origin device, instead stating that "when there is an outgoing call . . . the network will route the call to the IP 23 to determine if the caller is the subscriber or some other party."⁴ That is, Bartholomew specifically teaches that calls are routed from the telephone of the caller to an intermediary IP to determine whether the caller is the subscriber. Because Bartholomew does not disclose "detecting, at an origin device, a voice utterance . . . and identifying, at said origin device, a callee identity associated with said utterance" and instead teaching an intermediary IP. The rejection of claims 1, 2, 4, 8, 10- 13, 15, 19, 21- 24, 26, 30, 50 and 51 should be withdrawn.

Bartholomew Is Not An Enabling
Disclosure of Applicants' Claims

There are two required aspects of anticipation. Not only must Bartholomew disclose each and every element of the claims of the present invention within the meaning of *Verdegaal* in order to anticipate the claims, but also Bartholomew must be an enabling disclosure of the claims of the present invention within the meaning of *In re Hoeksema*. The Appellants' claims in *Hoeksema* were rejected because an earlier patent disclosed a close structural similarity to appellant's chemical compound. The court in *Hoeksema* stated: "We think it is sound law, consistent with the public policy underlying our patent law, that before any publication can amount to a statutory bar to the grant of a patent, its disclosure must be such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention." *In re Hoeksema*, 399 F.2d 269, 273, 158 USPQ 596, 600 (CCPA 1968). The *Hoeksema* court contrasted the so-called 'Von Brumer doctrine' with the requirement for a reference to be enabling:

In *In re Brown*, 51 CCPA 1254, 329 F.2d 1006, 141 USPQ 245 (1964), this court discussed *In re Von Brumer*, 29 CCPA 1018, 127 F.2d 149, 53 USPQ 345 (1942),

³ U.S. Patent No. 5,572,583, abstract, emphasis added.

⁴ U.S. Patent No. 6,167,119, column 33, lines 40-45, emphasis added.

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commenting that that opinion should not be construed to encompass what had come to be called the "Von Bramer doctrine." There we stated, 51 CCPA at 1257, 329 F.2d at 1009, 141 USPQ at 247:

This doctrine which appears to have resulted from *In re Von Bramer et al.*, *supra*, seems over a period of years to have been tailored in some quarters to a principle which defeats the novelty of a chemical compound on the basis of a mere printed conception or a mere printed contemplation of a chemical "compound" irrespective of the fact that the so-called "compound" described in the reference is not in existence or that there is no process shown in the reference for preparing the compound, or that there is no process known to a person having ordinary skill in the relevant art for preparing the compound. In other words, a mere formula or a mere sequence of letters which constitute the designation of a "compound," is considered adequate to show that a compound in an application before the Patent Office, which compound is designated by the same formula or the same sequence of letters, is old. We do not think that the Von Bramer case should be so construed.

To the extent that anyone may draw an inference from the Von Bramer case that the mere printed conception or the mere printed contemplation which constitutes the designation of a "compound" is sufficient to show that such a compound is old, regardless of whether the compound is involved in a 35 USC 102 or 35 USC 103 rejection, we totally disagree.

The meaning of *Hoeksema* for the present case is that it is insufficient as anticipation under 35 USC 102(e) for Bartholomew to express a "mere printed conception" or "mere printed contemplation" of some of the elements of the claims of the present application. Bartholomew's description of an intelligent telephone network that provides personalized communication services based on subscriber prescribed double speech signal processing of utterances of both the calling and answering parties 'mentions' for example the words

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utterances, but does not enable the claims of the present application. Bartholomew's mere printed mention of a word found in the present application cannot possibly be legally insufficient to show that the present invention is not patentable. The test for sufficiency of enabling disclosure is whether it places an invention in the possession of a person of ordinary skill in the art, and Bartholomew is legally insufficient to enable one of ordinary skill in the art to, for example, identify a particular callee, detect, at a destination device, a voice utterance of a callee; or identify, at said origin device, a callee identity associated with the voice utterance.

Independent claims 1, 12, and 23, also recite "said callee identity is transmittable as an authenticated identity of said callee for a call." The Office Action does not mention the phrase or demonstrate how Bartholomew teaches that a "callee identity is transmittable as an authenticated identity of said callee for a call." Independent claims 1, 12, and 23, as well as their rejected dependent claims 2, 4, 8, 10-13, 15, 19, 21, 22, 24, 26, and 30 should be allowed.

Claim Rejections – 35 U.S.C. § 103

Claims 3, 7, 9, 14, 19, 20, 25, 29, 43, and 48 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Bartholomew in view of McAllister (U.S. Patent No. 6,101,242), Timonen (U.S. Pub. No. 2002/0058494), Silverman (U.S. Patent No. 5, 875, 240), Baker (U.S. Patent No. 5, 533,109), or Gallick (6,678,359). Applicants respectfully traverse each rejection. Not one of the proposed combinations can establish a prima facie case of obviousness.

To establish a prima facie case of obviousness, three basic criteria must be met. *Manual of Patent Examining Procedure* §2142. The first element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a suggestion or motivation to combine Bartholomew and McAllister, Timonen, Silverman, Baker, or Gallick. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The second element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a reasonable expectation of success in the proposed combination of Bartholomew and

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McAllister, Timonen, Silverman, Baker, or Gallick. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). The third element of a prima facie case of obviousness under 35 U.S.C. § 103 is that the proposed combination of Bartholomew and McAllister, Timonen, Silverman, Baker, or Gallick must teach or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). As demonstrated below, the proposed combination of Bartholomew and McAllister, Timonen, Silverman, Baker, or Gallick establishes a prima facie case of obviousness. The rejection of claims should therefore be withdrawn and the case should be allowed.

Bartholomew and McAllister

Claims 3, 14, and 25 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Bartholomew in view of McAllister. The combination of Bartholomew and McAllister cannot establish a prima facie case of obviousness because the proposed combination does not teach each and every element of 3, 14, and 25, there is no suggestion or motivation to make the proposed combination, and there is no reasonable expectation of success in the proposed combination.

The Combination of Bartholomew and McAllister
Do Not Teach All of Applicants' Claim Limitations

The combination of Bartholomew and McAllister does not teach or suggest all of Applicants' claim limitations. Rejected claims 3, 14 and 25 depend from claims 1, 12, and 23 respectively. Claims 3, 14, and 25 therefore include the limitations "identifying, at said origin device, a callee identity associated with said utterance," "means for identifying, at said origin device, a callee identity associated with said utterance," and "means, recorded on said recording medium, for detecting a voice utterance . . . at an origin device" respectively. Neither Bartholomew nor McAllister teach these limitations. In fact, both Bartholomew and McAllister incorporate the same definition of an IP from Wheeler, Jr.⁵ Bartholomew at column 14, lines 10-14, discloses that when a serving

⁵ U.S. Patent No. 6,167,119, column 11, line 63 – column 12, line 6 ("IP 23 is essentially similar to that disclosed in commonly assigned U.S. Pat. No. 5,572583 to Wheeler, Jr. et al. . . . the disclosure of the

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central office detects a call to a line having the personalized service, processing hits a terminating attempt trigger. The central office interacts with its data link and routes the call to the IP23. That is, the call is received at the central office, processed, and then routed to IP23 for caller information. Therefore, both references lack the same teaching - "detecting, at an origin device, a voice utterance . . . and identifying, at said origin device, a callee identity associated with said utterance" as claimed in claims 3, 14, and 25. Because the combination of Bartholomew and McAllister does not teach each and every limitation of claims 3, 14, and 25, the combination of Bartholomew and McAllister cannot establish a prima facie case of obviousness.

No Suggestion or Motivation to Combine
Bartholomew and McAllister

There is no suggestion or motivation to combine Bartholomew and McAllister, because the proposed combination changes the principle of operation of Bartholomew. "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious."⁶ Bartholomew discloses that "when there is an outgoing call . . . the network will route the call to the IP 23 to determine if the caller is the subscriber or some other party."⁷ That is, Bartholomew specifically teaches that calls are routed from the telephone of the caller to an intermediary IP to determine whether the caller is the subscriber. To modify Bartholomew to teach "detecting, at an origin device, a voice utterance . . . and identifying, at said origin device, a callee identity associated with said utterance" would change the principle of operation of Bartholomew. As such, the combination of Bartholomew and McAllister therefore cannot establish a prima facie case of obviousness.

network and operation of the IP disclosed from that Patent is incorporated herein in its entirety by reference."); U.S. Patent No. 6,101,242, column 12, lines 48-57 ("IP 23 is essentially similar to that disclosed in commonly assigned U.S. Pat. No. 5,572583 to Wheeler, Jr. et al. . . . the disclosure of the network and operation of the IP disclosed from that Patent is incorporated herein in its entirety by reference.").

⁶ *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

⁷ U.S. Patent No. 6,167,119, column 33, lines 40-45, emphasis added.

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No Reasonable Expectation of Success in the
Proposed Combination of Bartholomew and McAllister

To establish a *prima facie* case of obviousness, there must be a reasonable expectation of success in the proposed combination of Bartholomew and McAllister. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). There can be no reasonable expectation of success in the combination of Bartholomew and McAllister if the proposed modification changes the principle of operation of either Bartholomew and McAllister. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). As discussed above, Bartholomew discloses that a call is received at the control center and is routed to IP23 for identification of the caller. (Bartholomew, Col 14, Lines 10-14) There is no reasonable expectation of success in the proposed combination. Because both Bartholomew and McAllister fail to teach "detecting, at an origin device, a voice utterance . . . and identifying, at said origin device, a callee identity associated with said utterance," the combination cannot work to detect, at an origin device, a voice utterance or identify, at said origin device, a callee identity associated with the utterance. That is, Bartholomew and McAllister together cannot do what both references cannot do alone. The combination therefore fails to establish a *prima facie* case of obviousness.

Bartholomew and Timonen

Claims 5, 6, 16, 17, 27 and 28 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Bartholomew in view of Timonen et al. (U.S. Patent Application No. 2002/0058494). The combination of Bartholomew and Timonen cannot establish *prima facie* case of obviousness, because the combination does not teach or suggest each and every element of claims 5, 6, 16, 17, 27 and 28. Furthermore, there is no suggestion or motivation in either Bartholomew or Timonen to make the proposed combination, nor is there any reasonable expectation of success in the proposed combination.

The Combination of Bartholomew and Timonen
Do Not Teach All of Applicants' Claim Limitations

The combination of Bartholomew and Timonen does not teach or suggest all the limitations of claims 5, 6, 16, 17, 27, and 28. More specifically, neither Bartholomew nor

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Timonen teach "detecting, at an origin device, a voice utterance of a callee from a destination device" or "identifying, at said origin device, a callee identity," as claimed in claims 5 and 5, "means for detecting, at said origin device, a voice utterance of a callee from a destination device" and "means for identifying, at said origin device, a callee identity," as claimed in claims 16 and 17, or "means, recorded on said recording medium, for detecting a voice utterance of a callee from a destination device at an origin device" and "means, recorded on said recording medium, for identifying, at said origin device, a callee identity," as claimed in claim 27 and 28. As discussed above, Bartholomew specifically teaches that calls are routed from the telephone of the caller to an intermediary IP to determine whether the caller is the subscriber. Bartholomew does not disclose "detecting, at an origin device, a voice utterance of a callee from a destination device" or "identifying, at said origin device, a callee identity." Timonen does also fails to disclose these limitations. Timonen instead discloses identifying a wireless user at a third party—not an origin device—for purposes of ensuring the charging of the user.⁸ Because the combination of Bartholomew and Timonen does not teach each and every element of claims 5-6, 16-17, and 27-28, the combination cannot establish a prima facie case of obviousness.

No Suggest or Motivation to Combine
Bartholomew and Timonen

There is no suggestion or motivation to combine Bartholomew and Timonen because the proposed combination changes the principle of operation of both Bartholomew and Timonen. "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious."⁹ The suggested combination of Bartholomew and Timonen changes the principle of operation of both references. First, Bartholomew discloses that "when there is an outgoing call . . . the network will route the call to the IP 23 to determine if the caller is the subscriber or some other party."¹⁰ That is, Bartholomew specifically teaches that calls are routed from the

⁸ Timonen, paragraph 0018.

⁹ *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

¹⁰ U.S. Patent No. 6,167,119, column 33, lines 40-45, emphasis added.

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telephone of the caller to an intermediary IP to determine whether the caller is the subscriber. To modify Bartholomew to teach “detecting, at an origin device, a voice utterance . . . and identifying, at said origin device, a callee identity associated with said utterance” changes the principle of operation of Bartholomew. Second, Timonen discloses “identifying a wireless user at a third party for purposes of ensuring the charging of the user.”¹¹ To modify the third party of Timonen to instead disclose “detecting, at an origin device, a voice utterance . . . and identifying, at said origin device, a callee identity associated with said utterance” changes the principle of operation of Timonen. As such, there is no suggestion or motivation to combine Bartholomew and Timonen.

No Reasonable Expectation of Success in the
Proposed Combination of Bartholomew and Timonen

The combination of Bartholomew and Timonen cannot establish a prima facie case of obviousness, because there is no reasonable expectation of success in the proposed combination. Since the proposed combination of the Bartholomew and Timonen fails to teach “detecting, at an origin device, a voice utterance of a callee from a destination device” or “identifying, at said origin device, a callee identity,” the combination cannot work to detect, at an origin device, a voice utterance of a callee or to identify, at said origin device, a callee identity. Said differently, Bartholomew and Timonen together cannot do what both references cannot do alone. As such, the combination of Bartholomew and Timonen cannot support a prima facie case of obviousness.

Bartholomew and Silverman

Claims 7, 18, 29, 43, and 48 stand rejected under 35 U.S.C § 103(a) as unpatentable over Bartholomew in view of Silverman. The combination of Bartholomew and Silverman also cannot establish a prima facie case of obviousness, because the proposed combination does not teach each and every element of claims 7, 18, 29, 43, and 48, there is no suggestion or motivation to make the proposed combination, and there is no reasonable expectation of the success in the proposed combination.

¹¹ Timonen, paragraph 0018.

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The Combination of Bartholomew and Silverman
Does Not Teach All of Applicants' Claim Limitations

The combination of Bartholomew and Silverman does not teach each and every element of claims 7, 18, 29, 43, and 48. Claims 7 recites "displaying said callee identity to said caller at said origin device," claim 18 recites "means for displaying said callee identity to said caller at said origin device." Claim 29 recites "means, recorded on said recording medium, for controlling output of said callee identity to said caller at said origin device," Claims 43 and 48 depend from claims 40 and 45 and therefore include the limitation "enabling output of said authenticated identity from said origin device . . . wherein said output comprises displayable output to a graphical user interface" and "means for enabling output of said authenticated identity from said origin device . . . wherein said output comprises displayable output to a graphical user interface."

The Office Action states "Silverman teaches displaying the called party identification information at the end-user device to which the call is routed before the call is answered." The "end-user device to which the call is routed before the call is answered"¹² cannot be an origin device, because it is the device to which the call is routed. Bartholomew also does not disclose "displaying said callee identity to said caller at said origin device," or "enabling output of said authenticated identity from said origin device . . . wherein said output comprises displayable output to a graphical user interface." The proposed combination of Bartholomew and Silverman therefore fails to teach each and every limitation of claims 7, 18, 29, 43, and 48, and cannot establish a prima facie case of obviousness.

No Suggest or Motivation to Combine
Bartholomew and Silverman

There is no suggestion or motivation to combine Bartholomew and Silverman because the proposed combination changes the principle of operation of both Bartholomew and Silverman. "If the proposed modification or combination of the prior art would change

¹² U.S. Patent No. 5, 875,240; column 2, lines 51-55.

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the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.”¹³ The suggested combination of Bartholomew and Silverman changes the principle of operation of both references. Bartholomew discloses that “when there is an outgoing call . . . the network will route the call to the IP 23 to determine if the caller is the subscriber or some other party.”¹⁴ That is, Bartholomew specifically teaches that calls are routed from the telephone of the caller to the intermediary IP to determine whether the caller is the subscriber. To modify Bartholomew to teach “detecting, at an origin device, a voice utterance . . . and identifying, at said origin device, a callee identity associated with said utterance” changes the principle of operation of Bartholomew. Moreover, Silverman teaches displaying called party identification information on the end-user device to which the call is routed before the call is answered.¹⁵ To modify Silverman to instead disclose “displaying said callee identity to said caller at said origin device” changes the principle of operation of Silverman. As such, there is no suggestion or motivation to combine Bartholomew and Silverman.

No Reasonable Expectation of Success in the
Proposed Combination of Bartholomew and Silverman

There is no reasonable expectation of success in the combination of Bartholomew and Silverman. Silverman teaches that “the routed call includes the called party identification information, which may be displayed on the end-user device to which the call is routed before the call is answered.” The combination of Bartholomew and Silverman will not therefore work to display “said callee identity to said caller at said origin device” as claimed in claims 7, 18, 29, 43, and 48, because it teaches displaying the called party identification “on the end-user device to which the call is routed.”

Bartholomew and Baker

Turning now to claims 9 and 20, claims 9 and 20 stand rejected under 35 U.S.C. § 103 as unpatentable over Bartholomew in view of Baker. The combination of Bartholomew and

¹³ *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

¹⁴ U.S. Patent No. 6,167,119, column 33, lines 40-45, emphasis added.

¹⁵ U.S. Patent No. 5,875,240; column 2, lines 51-55.

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Baker also cannot establish a prima facie case of obviousness because the proposed combination does not teach each and every element of claims 9 and 20, there is no suggestion or motivation to make the proposed combination, and there is no reasonable expectation of the success in the proposed combination.

The Combination of Bartholomew and Baker
Does Not Teach All of Applicants' Claim Limitations

The proposed combination of Bartholomew and Baker does not teach each and every element of claims 9 and 20. Claim 9 depends from independent claim 1 and includes the limitations "detecting, at an origin device, a voice utterance . . . and identifying, at said origin device, a callee identity associated with said utterance." Claim 20 depends from claim 12 and includes the limitations "means for detecting, at an origin device, a voice utterance . . . and means for identifying, at said origin device, a callee identity associated with said utterance." Neither Bartholomew nor Baker teach these limitations.

Bartholomew specifically teaches away from claims 9 and 20, instead disclosing that "when there is an outgoing call . . . the network will route the call to the IP 23 to determine if the caller is the subscriber or some other party."¹⁶ Baker discloses a "private branch exchange system having various call servicing features for calls terminating at branch exchange telephonic units of the system."¹⁷ Baker does not teach or disclose "detecting, at an origin device, a voice utterance . . . and identifying, at said origin device, a callee identity associated with said utterance." Because the proposed combination of Bartholomew and Baker fails to teach every element of claims 9 and 20, the combination cannot establish a prima facie case of obviousness.

No Suggestion or Motivation to Combine
Bartholomew and Baker

There is no suggestion or motivation to combine Bartholomew and Baker because the proposed combination changes the principle of operation of Bartholomew. "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references

¹⁶ U.S. Patent No. 6,167,119, column 33, lines 40-45, emphasis added.

¹⁷ Baker, column 1, lines 6-12.

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are not sufficient to render the claims *prima facie* obvious.”¹⁸ Bartholomew discloses that “when there is an outgoing call . . . the network will route the call to the IP 23 to determine if the caller is the subscriber or some other party.”¹⁹ That is, Bartholomew specifically teaches that calls are routed from the telephone of the caller to an intermediary IP to determine whether the caller is the subscriber. To modify Bartholomew to teach “detecting, at an origin device, a voice utterance . . . and identifying, at said origin device, a callee identity associated with said utterance” would change the principle of operation of Bartholomew. As such, there is no suggestion or motivation to modify or combine Bartholomew and Baker. Bartholomew and Baker therefore cannot establish a *prima facie* case of obviousness.

No Reasonable Expectation of Success in the
Proposed Combination of Bartholomew and Baker

There is also no reasonable expectation of success in the combination of Bartholomew and Baker. Because neither Bartholomew nor Baker teach “detecting, at an origin device, a voice utterance” or “identifying, at said origin device, a callee identity associated with said utterance,” the combination cannot work to identify “detecting, at an origin device, a voice utterance” or “identifying, at said origin device, a callee identity associated with said utterance.” That is, Bartholomew and Baker together cannot do what neither reference can do alone. The combination of Bartholomew and Baker cannot establish a *prima facie* case of obviousness.

Gallick and Well Known Prior Art

Claims 40, 41, 43-46, 48, 49 and 52 stand rejected for obviousness under 35 U.S.C § 103(a) as unpatentable over Gallick in view of well known prior art. The combination of Gallick and well known prior art also cannot establish a *prima facie* case of obviousness because the proposed combination does not teach each and every element of claims 40, 41, 43-46, 48, 49 and 52, there is no suggestion or motivation to make the proposed combination, and there is no reasonable expectation of the success in the proposed combination.

¹⁸ *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

¹⁹ U.S. Patent No. 6,167,119, column 33, lines 40-45, emphasis added.

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The Combination of Gallick and Well Known Prior Art
Does Not Teach All of Applicants' Claim Limitations

The proposed combination of Gallick and well known prior art does not teach each and every element of claims 40, 41, 43-46, 48, 49 and 52. Independent claim 40 claims:

detecting a voice utterance of a callee at an origin device originating a call;
authenticating an identity of said callee from said voice utterance at said origin device; and
enabling output of said authenticated identity from said origin device, such that a caller accessing said origin device is informed of an identity of said callee.

And independent claim 52 claims:

detecting , at a call initiating telephony apparatus, a voice utterance of a callee from a destination device; and
identifying, at the call initiating telephony apparatus, a callee identity associated with said voice utterance, such that said callee identity is transmittable as an authenticated identity of said callee for a call.

The Office Action states that, except for "origin device originating a call," the elements of independent claim 40 are taught by Gallick at figure 1, figure 4, figure 6, column 3 lines 12-53 and lines 44-53, column 5 lines 30-36, column 6 lines 3-14 and lines 27-59, and column 7 lines 1-6. These cited portions of Gallick, however, do not teach all the elements for which they are cited. Gallick at column 3, lines 45 – 51, for example, states "... the first utterances of the called party will be captured and analyzed to determine if the voice sample corresponds to one on file. If the called individual is identified, an appropriately formatted message will be transmitted to the calling subscriber." Reference 278 on figure 2b in Gallick states, "Send the captured utterance to a local speaker identification routine," making it clear that the identification of the voice utterance in Gallick is performed on the called device. Gallick at column 6 lines 3-14 states that an

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identifying utterance is "... captured and sent to a local voice identification recognizer located on the local personal computer where the softphone resides or on a server on the network where the softphone resides," making it clear that such identification is NOT performed on an origin device or on an initiating telephony apparatus, again teaching directly away from the claims of the present invention. Clearly Gallick cannot be said to teach the elements of the claims of the present invention which claim detecting an utterance, authenticating identity, and output of the identity of a callee all from and upon an origin device originating a call or upon an initiating telephony apparatus because Gallick teaches directly away from these elements of the claims of the present application.

Similarly, Gallick at column 5 lines 30-36 is clearly describing processing that occurs in the "called facility," again teaching directly away from the claims of the present application. And Gallick at column 6 lines 51-59, in describing the message flow illustrated in figure 6, makes it very clear that the out of band message 620 transmitted in lieu of message 615 is sent "back to the calling party indicating the party speaking at the called telephone instrument," again teaching directly away from the origin device processing and the initiating telephony apparatus processing claimed in the present invention. And Gallick at column 7 lines 1-6 makes it clear that called-ID information is transmitted "to calling telephones," again teaching directly away from the claims of the present invention in which identify information of a callee is output FROM an origin device or an initiating telephony apparatus such as, for example, a calling telephone as opposed to a called telephone. The proposed combination of Gallick and well known prior art for all these reasons fails to teach each and every limitation of claims 40, 41, 43-46, 48, 49 and 52 and therefore cannot establish a prima facie case of obviousness.

Well Known Prior Art Is
Not Available As A Reference

The Office Action states at the top of page 12, "Examiner takes Official Notice that calling party's VoIP softphone (i.e., origin device) originating a call that has the speech recognition feature for identifying an answering party of the call are well known in the

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art." Applicants respectfully propose, however, that Official Notice of "calling party's VoIP softphone (i.e., origin device) originating a call that has the speech recognition feature for identifying an answering party of the call" is not available to the Examiner in this case to represent well known prior art.

According to MPEP § 2144.03, the Examiner may take Official Notice of facts outside the record only if such facts are capable of instant and unquestionable demonstration as being well-known in the art. Official Notice, however, may not be substituted for facts which cannot be instantly and unquestionably demonstrated. As indicated in In re Lee, 277 F.3d at 1343-44, 61 USPQ at 1433-34, the examiner's finding of whether there is a teaching, motivation or suggestion to combine the teachings of the applied reference must not be resolved based on "subjective belief and unknown authority," but must be "based on objective evidence of record." The court in Lee requires evidence for the determination of unpatentability by clarifying that "common knowledge and common sense," as mentioned in In re Bozek, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969), may only be applied to analysis of the evidence, rather than be a substitute for evidence. Lee, 277 F.3d 1345, 61 USPQ2D at 1435.

In this case, Applicants note with respect that the Examiner has made a mere naked assertion that a fact is well known in the prior art with absolutely no "objective evidence of record" and no expression of any reason why one having ordinary skill in the pertinent art would have been led to modify the prior art to arrive at the claimed invention. As mentioned, Official Notice may not be substituted for facts which cannot be instantly and unquestionably demonstrated. For these reasons, the Examiner in this case cannot have recourse to Official Notice of facts well known in the prior art and this rejection therefore fails to establish a prima facie case of obviousness.

No Suggestion or Motivation to Combine
Gallick and Well Known Prior Art

There is no suggestion or motivation to combine Gallick and well known prior art because the proposed combination changes the principle of operation of Gallick. "If the

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proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie obvious*.²⁰ As noted above, the entire principle of operation disclosed in Gallick is utterance processing on a called device, teaching directly away from the claims of the present invention which claim utterance processing on an origin device or an initiating telephone apparatus. Obviously the utterance processing on an origin device cannot be combined with Gallick's utterance processing on a called device without changing the principle of operation of Gallick. Because such a combination would destroy the principle of operation of Gallick, there could be no possibility of any suggestion to combine in Gallick, and Gallick in combination with the cited well known prior cannot be used to establish a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, there must be a suggestion or motivation to modify Gallick. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The suggestion or motivation to modify Gallick must come from the teaching of Gallick itself and the Examiner must explicitly point to the teaching within Gallick suggesting the proposed modification. Absent such a showing, the Examiner has impermissibly used "hindsight" occasioned by Applicants' own teaching to reject the claims. *In re Surko*, 11 F.3d 887, 42 U.S.P.Q.2d 1476 (Fed. Cir. 1997); *In re Vaeck*, 947 F.2d 488m 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re Gorman*, 933 F.2d 982, 986, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.,2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989). There is not a single word in Gallick that makes any hint of combining with Gallick a "calling party's VoIP softphone (i.e., origin device) originating a call that has the speech recognition feature for identifying an answering party of the call" as noticed by the Examiner. For this reason also, Gallick in combination with the cited well known prior cannot be used to establish a *prima facie* case of obviousness.

²⁰ *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

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No Reasonable Expectation of Success in the Proposed
Combination of Gallick and Well Known Prior Art

There is also no reasonable expectation of success in the combination of Gallick and well known prior art. Clearly there can be no reasonable expectation of success in combining utterance processing in an origin device with technology whose principles of operation are based on utterance processing in a called device or an intermediary server. The hardware designs are different, the processing requirements are different, and so on. There can be no reasonable expectation of success in such a combination and proposing such a combination cannot establish a *prima facie* case of obviousness.

Gallick, Well Known Prior Art, and Bartholomew

Claims 42 and 47 are rejected for obviousness under 103(a) over Gallick in view of well-known prior art and further in view of Bartholomew. Claims 42 and 47 depend respectively from 40 and 45. Claims 40 and 45 stand for the reasons set forth above, and therefore 42 and 47 stand also. Claim 45 is an independent claim that claims the system aspects of the method claims in claim 40 – so that claim 45 stands for the same reasons that claim 40 stands. Claims 41, 43, and 44 depend from independent claim 40 and stand for the same reasons that claim 40 stands. Claims 46, 48, and 49 depend from independent claim 45 and stand for the same reasons that claim 45 stands. For all these reasons, the rejections of claims 40, 41, 43-46, 48, 49 and 52 should be withdrawn.

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Conclusion

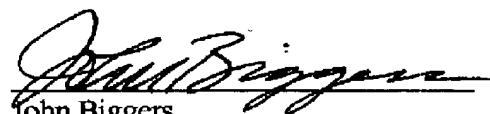
Bartholomew does not anticipate claims 1, 2, 4, 8, 10-13, 15, 19, 21, 22, 24, 26, 30, 40-42, 44-47 and 49-51 within the meaning of 35 USC 102. Bartholomew alone or in combination with McAllister, Timonen, Silverman, Baker, Gallick, or well known prior art do not establish a prima facie case of obviousness according to 35 USC 103.

Bartholomew alone or in combination with McAllister, Timonen, Silverman, Baker, Gallick, or well known prior art does not teach each and every element of claims 1-30 and 40-52. The proposed combinations of Bartholomew and McAllister, Timonen, Silverman, Baker, Gallick, and well known prior art also fail to establish a prima facie case of obviousness because the proposed combinations present no suggestion or motivation to make the proposed combinations, and there is no reasonable expectation of success in the proposed combinations. Applicants therefore respectfully request the allowance of claims 1-30 and 40-52.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

Respectfully submitted,

Date: 8/9/04 By:



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